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6713-St-ar**REMARKS**

Claims 2-9, 11 and 12 are pending, although claim 11 has been withdrawn from consideration as drawn to a non-elected invention. Applicants respectfully request that, upon allowance of elected subject-matter, the non-elected subject matter be rejoined.

***35 U.S.C. 103(a) rejection***

Claims 2-9 and 12 were rejected by the examiner as being obvious over Patel et al. (U.S. Patent 5,385,783) in view of Sakumoto et al. (U.S. Patent 5,683,806) and Leeuwenburgh (U.S. Patent 5,935,669).

***Background of the Rejection***

Of the differences between the Patel reference and that of the applicants invention, the examiner acknowledges that Patel does not:

- (1) disclose a film;
- (2) disclose a specific width or thickness for the adhesive tape;
- (3) disclose that the masking film is folded; and
- (4) disclose a polyolefin film.

Before the applicants address the examiner's explanation as to why the teachings of Patel et al., Sakumoto et al. and/or Leeuwenburg allegedly renders the applicants invention to be obvious, it is pointed out that Patel et al. has other differences from the applicants invention.

***Patel et al. has other differences not addressed in the office action***

- (5) The first additional difference which has not been accounted for is that the

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applicants limitation a) in claim 12 states "a heat-resistant adhesive tape comprising ✓  
*a paper support one side of which is coated with a contact adhesive;...*"

Patel et al. does not teach this limitation. Figure 3 of Patel et al. which has been redrawn below for comparative purposes *does not* have the adhesive coating the paper support, *the adhesive contacts the primer.*

Fig. 3 (see also col. 4, lines 43-46)

64 – adhesive layer
62 – primer layer
58 – impregnated paper
60 – release coat

(6) The second difference is that the applicants invention requires that the contact adhesive is partially covered by masking paper (i.e. limitation b) in claim 12) and the remainder of the contact adhesive is covered by a masking film (i.e. limitation c) in claim 12). See simplified diagram of applicants masking strip below:

Masking paper/Masking film
Contact adhesive layer
Paper support

Patel et al. does not teach or suggest the use of a masking paper/masking film on the contact adhesive layer. One of ordinary skill in the art would not be motivated to add this feature to the invention of Patel et al. because their adhesive layer 64 is protected by the release coat 60 as the tape is rolled up (see col. 2, lines 31-34).

*Sakumoto et al. and Leeuwenburgh do not account for the additional differences*

Obviously, the additional differences (5) and (6) now cited by the applicants above could

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not have been considered in the previous office action. As such, the examiner was relying upon the Sakumoto et al. and Leeuwenburgh references to account for the differences (1) – (4) acknowledged by the examiner between the Patel et al. reference and the applicants' claimed invention. With these additional differences, even if Sakumoto et al. and Leeuwenburgh were applicable as cited by the examiner, a *prima facie* case of obviousness has not been established.

As it is a moot point at this stage of the rejection, Sakumoto et al. and Leeuwenburgh are not addressed in great detail here. However, it is noted that each reference was relied upon for specific elements or teachings which allegedly could be taken selectively and substituted into the invention of Patel et al. The statements of motivation appear to come from the examiner's hindsight reasoning and not from any specific teaching from the references themselves.

The examiner is reminded that the invention as well as the references cited must be considered as a whole and that it has previously been held that "*it is impermissible* within the framework of section 103 *to pick and choose* from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." (sec *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)). Given that there are at least 6 separate differences between Patel et al. and the prior art, it is believed that the Sakumoto et al. and Leeuwenburgh references do not teach/suggest and provide the motivation for making the appropriate changes to the Patel et al invention to arrive at the applicants' claimed invention.

#### *Closing*

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the

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undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 (5 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 30 July 2002

By   
Vilma I. Fernandez